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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,993	03/31/2004	Danilo Lambino	J&J5118	1398

27777 7590 04/06/2006

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EXAMINER

BOYER, CHARLES I

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/814,993

Applicant(s)

LAMBINO ET AL.

Examiner

Charles I. Boyer

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-8, 11, 14-16 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11, 14-16, 19, and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to applicants' amendment and response received January 9, 2006. Claims 1-3, 5-8, 11, 14-16, and 19-25 are currently pending.

#### ***Election/Restrictions***

1. Newly submitted claims 21-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are drawn to a method for whitening the skin.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 14-16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Slavtcheff et al, US 6,270,783.

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Slavtcheff et al teach skin treatment compositions impregnated on a substrate (see abstract). An example of such a composition is a nonwoven fabric containing a resin dispersed in water along with microencapsulated cholesteryl ester carbonate (col. 8, example 1). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Applicants have traversed this rejection on the grounds that the only products for application to the skin described in Slavtchef are adhesive strips that are "dry-to-the-touch" and so the reference fails to teach or suggest any product for use on the skin that comprises a liquid impregnate. The examiner acknowledges the reference teaches a "dry to the touch" strip. However, as the strip is still impregnated with a liquid, and "dry to the touch" does not mean that zero liquid is present, the examiner maintains this limitation is still satisfied.

3. Claims 1-3, 5, 8, 14-16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Charle et al, GB 1,304,375.

Charle et al teach make-up removing towels comprising a microencapsulated cream wherein the microcapsule is an acrylic acid polymer at a size as high as 100 microns. The microcapsules are incorporated into cellulose acetobutyrate, which is dried, and then placed in absorbent paper napkins (col. 5, example 2). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Applicants have traversed this rejection on the grounds that the only products for application to the skin described in Charle et al are dry, and so the reference fails to teach or suggest any product for use on the skin that comprises a liquid impregnate. The examiner acknowledges the reference teaches a dried towel. However, as the towel is still impregnated with a liquid, and the "dried towel" does not mean that zero liquid is present, that is, the towel is not dripping wet certainly, but some cream must be present for application to the skin, the examiner maintains this limitation is still satisfied.

4. Claims 1-3, 5-8, 14-16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Norbury et al, US 4,878,775.

Norbury et al teach a device for applying liquid to a skin surface, such as applying cosmetics, deodorants, medications, or cleansers (see abstract and col. 1, lines 10-14). An example of such a device comprises a water-borne adhesive applied to a non-woven polyester fiber web, and further contains urea formaldehyde capsules having a size between 600 and 1000 microns and containing a fragrance oil (col. 5, example 1). Note that the capsules may have a diameter as small as 200 microns (col. 3, lines 16-32). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Applicants have traversed this rejection on the grounds that the web of Norbury et al does not comprise a liquid impregnate. Note however, that when the liquid-filled, impregnated capsules are ruptured, the liquid flows into the web. At this point, the liquid

impregnate limitation is satisfied, albeit not in the same way applicants envision in their invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 11, 14-16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al, US 6,429,261.

Lang et al teach fabrics impregnated with personal care compositions (see abstract). An example of such a composition is a wet wipe wherein a wetting composition is applied to the wipe (col. 39, lines 36-50). Said wetting composition may contain microcapsules as a delivery vehicle for skin care benefit agents such as retinol, retinyl palmitate, tocopherol, silicones, and mineral oil (col. 29, lines 5-19). Lang et al do not specifically teach a wipe containing microcapsules, however as Lang et al clearly teach microcapsules as a preferred delivery method for skin care agents in their wet wipe compositions, it would have been obvious to one of ordinary skill in the art to incorporate microcapsules in a wipe according to the teachings of Lang et al. With respect to specific compositions and properties of the microcapsules, the examiner notes that the microcapsules of the reference are commercially available and are believed to encompass these limitations.

Applicants have traversed this rejection on the grounds that their invention achieves an unexpectedly high increase in whitening to the skin and other beneficial properties as compared to products outside the claimed invention and have cited examples in the present specification in support of this assertion. Such purported unexpected results however, are not commensurate in scope with the claims at hand. A product is being claimed, not a method for whitening the skin. Accordingly, the rejection is maintained.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-Th 9:30 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571 272 1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles I Boyer  
Primary Examiner  
Art Unit 1751